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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,053	06/28/2000	Eric Lauzon	584-1027	5671

7590 12/31/2003  
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EXAMINER

HARTMAN JR, RONALD D

ART UNIT - PAPER NUMBER

2121

DATE MAILED: 12/31/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/606,053

Applicant(s)

LAUZON ET AL.

Examiner

Ronald D Hartman Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the Amendment filed on 9/9/2003.
2. Claims 1-11 and 14 are represented for further examination.

### ***Response to Arguments***

3. The applicant's arguments with respect to claims 1-11 and 14 have been considered but are moot in view of the new grounds of rejection set forth below.
4. It is noted that claims 12-13 and 15-24 have not canceled. These claims were not chosen by way of the Election, (See previous office action), and therefore they should be canceled in response to this office action.

### ***Claim Objections***

5. Claim 7, line 3, is objected to because of the following informalities: change "that" to "the destination" to be clearer.
6. Claim 1, line 9, "the originating terminal controls" should be "the software code controls" since the software code is actual providing the control, this code having been issued, or transmitted from the originating terminal. See pending claim 8.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2 and 14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Edwards et al., U.S Patent No: 6,502,127.

9. As per claim 1, Edwards clearly teaches the claimed system of creating a message containing software code, and having this message transmitted to a destination terminal, where the code is executed to control a function of the destination terminal, as claimed by way of pending claims 1 and 14 (Claim 1).

10. As per claim 14, a client, arranged to receive the message, is inherent to Edwards (See Figure 1).

11. As per claim 2, Edwards clearly teaches an authorization step before executing the code in the message (Claim 4).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, as applied to claim 1 above, and further in view of Schuster et al., U.S Patent No. 6,584,490.

14. As per claims 3-10, Edwards does not specifically claim the specific call control features, as claimed by claims 3-10.

Schuster teaches a plethora of call control features (C1 L27- C2 L49). The incorporation of these features, including priorities, voice mail routing, changing of operating parameters (configuration) and call forcing are all believed to be either taught by Schuster, or are at least obvious variations thereof, since they are all features that are for call control and therefore they would all provide for a more flexible telephone control system.

Therefore, since Schuster teaches the need for these call control features in an IP telephony system, and since Edwards teaches an IP telephony system, these particular features would obviously be effective for providing more control over the destination terminal, and therefore their incorporation into Edwards would be obvious since, at the very least, they would allow for simple, flexible and effective call control by

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providing an abundance of call control features, and this would have been obvious at the time the invention was made.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, as applied to claim 1 above, and further in view of Donovan et al., U.S Patent No. 6,615,236.

16. As per claim 11, Edwards does not specifically teach an IP telephony system having SIP as its signaling protocol.

Donovan teaches SIP and the use of JAVA for an IP telephony system (e.g. Claim 1 and Abstract).

It would have been obvious to one of ordinary skill in the art at the invention was made to have incorporated call control for an IP telephony system, as disclosed by Edwards into the framework of SIP, as taught by Donovan since it would be easy to implement and debug, as disclosed by Donovan (C1 L41-44).

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Hartman Jr. whose telephone number is (703) 308-7001. The examiner can normally be reached 10:30-8:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri, can be reached at (703) 305-0282.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9618.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306

**Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).**

Ronald D. Hartman Jr.  
Patent Examiner  
Art Unit 2121  
December 28, 2003



**ANIL KHATRI**  
**SUPERVISORY PATENT EXAMINER**